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No. 5714

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

LOUIS ONEAL,

Appellant,

VS.

SAN JOSE CANNING COMPANY

(a corporation),

Appellee.

BRIEF FOR APPELLANT.

CLARENCE A. LINN,

Mills Building, San Francisco,

Attorney for Appellant.

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Appellant sued to enjoin defendant from infringing on a patent covering a device for and process of canning string beans. The patent was sustained *in toto* by the District Court, but on appeal the process patent was held void, but the patent on the device was upheld. (*San Jose Canning Company v. Oneal*, 10 Fed. (2) 100.)

Thereupon, the District Court referred the matter to a special master to determine the profits derived by appellee by reason of its use of appellant's device, and to report to the court.

Appellant's contention before the special master is briefly stated in the master's opinion and order of January 31, 1928:

“The complainant’s contention, on the other hand, is that the packing of string beans, whole, lengthwise in the can, in the manner of asparagus stalks was not known in the art until plaintiff’s device, two semi-circular molds with certain accessories, which bunch the beans and facilitate their insertion into the cans, created that particular style of packing; that prior thereto, string beans were not packed asparagus style by hand, but were packed cut up into pieces. Plaintiff’s contention, accordingly, is that the selected standard of hand packing is not applicable under the law and that plaintiff is entitled to the entire profits of defendant for beans packed by the infringing device in the asparagus style originated by plaintiff, there being no hand operation for such packing then known.

“It is, of course, settled law that a device or method not known at the time of the infringement is not available as a standard of comparison, 277 Federal, 177; Walker, Section 725. If plaintiff is correct on the facts, his claim that he is entitled to all the profits of beans packed asparagus style, without reference to any standard of comparison, would seem on my present understanding to be correct.” (Record, p. 60.)

This quotation not only tersely states the contention but the law applicable thereto.

Thereafter, a hearing was had to ascertain whether or not there was a “standard of comparison” available to appellee. On May 21, 1928, the special master rendered an opinion on the question of “standard of comparison” in which he summarized the facts as follows:

“The evidence taken shows that during the season in 1922 for packing string beans, which season begins each year toward the last of July, the defendant paid a royalty to plaintiff of \$500. At that time the application of Rancadore, Gen-

eral Manager of defendant, for the mold later declared to be an infringement of the Greco mold of plaintiff was before the patent office. Toward the end of July, Mr. Rancadore asked one of his employees to get up a device which would facilitate hand packing of string beans asparagus style. The result was the model Exhibit 1. This is a block of wood around which at each end was bent and secured a piece of half-round iron, forming upwardly projecting arms within which a bunch of string beans could be placed on the block, after which the ends were trimmed off with a knife. The upwardly extending iron prongs fulfilled the function of gauging the quantity of beans to be packed in the can and of retaining them while the cutting was going on. The bunched string beans, after having been trimmed, were then taken out of the device by hand and placed in the can. Defendant's manager, Mr. Rancadore, having tried this operation with some half dozen cans, did nothing further with it. In the seasons of 1923 and 1924 payment of royalty was refused, and defendant packed by the Rancadore mold, declared later to be an infringement.

During the seasons of 1925 and 1926, defendant packed by hand, using to facilitate hand packing the device in evidence as exhibit 2. This is the same as Exhibit 1 except for the fact that the block projects at each end beyond the iron uprights, affording thus a surface to facilitate a clean cut with the knife.

The account which defendant has filed is based upon a comparison between the cost in filling the can with string beans by the use of the infringing mold and the cost of trimming the beans and filling the can by hand packing aided by Exhibit 2.

The facts stated are abundantly proved, with every evidence of plausibility and with no opposing evidence. It is not claimed that Exhibit 2 is an infringing device, and it seems obvious that it is not. The conclusion therefore follows that the

hand packing method of defendant as described and as practiced in the seasons of 1925 and 1926 had been substantially developed by him as early as July 1922; that he could have used hand packing aided by either Exhibit 1 or Exhibit 2 in the years 1923 and 1924 when he used the infringing mold, and that therefore this hand packing as practiced is a proper standard of comparison to be used in this accounting. The fact that there is a slight difference, as described, between Exhibit 1 and Exhibit 2, is immaterial. Exhibit 1 could have been used, *but the modification by extending the block to facilitate cutting was obvious and a development that ensued naturally as soon as the method was put in practice.*" (Record, p. 136.)

At a later hearing the witness Victor Greco testified that it was commercially impractical to pack string beans "asparagus style" without the use of appellant's patented device or some such mold as was used by appellee and considered by the special master as a standard of comparison. (Testimony of V. Greco, Record, p. 144.)

The same witness testified that never prior to 1922 did any one other than appellant's assignors pack string beans "asparagus style." This testimony is uncontradicted. (Testimony of V. Greco, Record, p. 123, et seq.)

The special master in his final report adopted the "standard of comparison" herein referred to, and assessed damages accordingly, to which ruling appellant has filed his exceptions. The report of the special master was affirmed and judgment entered accordingly.

ASSIGNMENT OF ERRORS.

Appellant contends that the law was correctly stated by the special master in his first ruling, quoted herein (and the special master has not reversed that ruling); that the special master has correctly stated the facts (as quoted above); but, in drawing his conclusions therefrom and in applying the law thereto, he has fallen into error, and that the District Court has erred in affirming the report of the special master.

ARGUMENT.

In order for a "standard of comparison" to be available to an infringer, it must be

" 'Then open to the public,' *Mowry v. Whitney*, 81 U. S. (14 Wall.) 620, 20 L. Ed. 860; 'in common use.' *Black v. Thorne*, 111 U. S. 122, 4 Sup. Ct. 326, 28 L. Ed. 372; 'known and in general use anterior to date of the patent,' *Sessions v. Romadka*, 145 U. S. 29, 12 Sup. Ct. 799, 36 L. Ed. 609; 'common and unrestricted use,' *Locomotive Safety Truck Co. v. P. R. Co.* (C. C.) 2 Fed. 677; 'free to everybody,' *National Car-Brake Shoe Co. v. Terre-Haute Car & Mfg. Co.* (C. C.) 19 Fed. 514; 'open to the defendants,' *Wales v. Waterbury Mfg. Co.*, 101 Fed. 126, 41 C. C. A. 250; 'known prior to complainant's invention,' *Fullerton Walnut Growers' Ass'n v. Anderson-Barn Grover Mfg. Co.*, 166 Fed. 443, 92 C. C. A. 295; 'gone into public use,' *Novelty Glass Mfg. Co. v. Brookfield*, 170 Fed. 946, 95 C. C. A. 516; 'open to the world,' *Cambria Iron Co. v. Carnegie Steel Co.*, 224 Fed. 947, 140 C. C. A. 437."

American Pneumatic Service Co. v. Snyder, 241 Fed. 274, 275.

The proposed "standard of comparison" was made in July, 1922, one night after work had ceased. The manager of appellee, one of his workmen (not one engaged in canning), and an employee of appellant's assignor, who was secretly aiding appellee, and under the compulsion of a threat of injunction met, and the result of the meeting was Model No. One, introduced before the special master.

"Q. Do you remember the packing season of 1922?

A. Yes.

Q. In 1922 did you **experiment** with packing beans in bunch form, so-called asparagus style?

A. Yes.

Q. Will you explain to the Court just what you did at that time, and, if possible, about the time in 1922 when you did it?

A. It was in the latter part of July, that is, when we got started packing string beans. I worked under a license from Anthony Greco.

Q. In 1922?

A. In 1922, and as soon as we got started packing string beans, I was wondering if something could be accomplished by hand without using any mold of any kind, so I told my assistant superintendent, Mr. Cusimano, to try and get up a form so that it would hold enough beans in there to fit into a can, and we tried several forms, and we finally got enough beans in this form to fit the No. 2 cans. This is the kind that we generally use in packing our string beans, except these are a little higher.

Q. That is the form, except the uprights were a little higher?

A. They were higher before. *So we tried it and about half a dozen cans were packed*, and we saw we could fit them exactly as the mold did, make a very good pack; more beans go into a can with that than with a mold, due to the fact that the mold is a little bit narrower than the can,

itself. In bunch form, we could put in as much beans as the cans will hold. Naturally, if the girls put in too many beans, they could pull some out, half a dozen or so.

Q. That is, with the mold?

A. No, with this here.

Q. With a mold it sometimes went under the required number of beans?

A. Yes, depending on the canner; if she did not put enough beans into the mold, naturally the can would be slack, and there wouldn't be enough beans in there to make a good pack, and when you open up a can the beans, instead of standing up in a bunch, will fall apart.

Q. At the time that you made this **experiment**, did you make any attempt to figure what the difference in cost might be?

A. No, we did not."

(Testimony of I. Rancadore, Manager of Defendant; Record, page 63, et seq.)

It will be observed that both counsel and witness for defendant referred to their activities as an **experiment**.

The fear of injunction passed for the moment and the appellee abandoned its experiment. In 1923 and 1924 appellee abandoned its license from appellant's assignor and used the device which has been held an infringement. In 1925, after the decision of the Circuit Court of Appeals, it was apparent that the appellee would have to abandon its infringing device. We will let the defendant speak through its manager:

"Mr. ARMSTRONG. Q. Mr. Rancadore, you did not take a license in 1923?

A. No.

Q. Nor in 1924?

A. No.

Q. During those two years, did you use any molds?

A. We used my mold.

Q. Your patent having previously been granted?

A. Yes.

Q. When you say 'my mold,' you mean the mold that was offered in evidence in this case which is now pending?

A. Yes.

Q. Then in 1925 what did you do?

A. As soon as we found out we could pack asparagus style string beans by any other method except the method of the mold similar to the Greco mold, we immediately went back to the hand pack, which we have continued ever since.

Q. You started that in the season of 1925?

A. Yes.

Q. While the suit was still pending?

A. Yes, it was pending, but the decision was already given, and at that time we took an appeal, and the appellate court decided that the claims——

The MASTER. We know all about that.

Mr. ARMSTRONG. Q. That suit was pending?

A. Yes.

Q. You went back to your form of mold that you **experimented** with in 1922?

A. Yes, this is the one we have been using.

Q. Will you explain the difference between the two molds?

A. We saw that when you cut the beans this way, the beans do not rest on anything here, they are kind of *limber*, *you do not make a clean cut on the bottom*, *so we extended the wood part here so that all of the beans rested on it*, *and when you cut you would make a clean cut.*

Q. The beans, before they had been put in the mold, had been blanched?

A. Yes.

Q. That was the mold that you had in 1923?

A. 1925, 1926, and 1927.

Q. It was upon the use of that mold in those years that you based the statement which you

have filed with this Court, and which you swore to on the 14th of October, 1926, as to comparative cost?

A. Yes.

Mr. ARMSTRONG. I wish to introduce in evidence the shorter one of these two models as Defendant's Exhibit 1, and the longer one as Defendant's Exhibit 2.

The MASTER. They will be so received and marked.

(The models were marked Defendant's Exhibits 1 and 2.)

Mr. ARMSTRONG. That is all."

(Testimony of I. Rancadore, Record, page 70, et seq.)

The model known as Model No. 1 is still referred to as an **experiment**. It had not yet been developed and continued experimentation disclosed its defects, and these had to be remedied before it could be used commercially.

Again, we let appellee's manager tell the story of his experiment:

"Q. In 1922, you operated under a license from Anthony Greco?

A. Of \$500, yes.

Q. And you used a mold which you, yourself, or someone in your employ, prepared, and which was subsequently offered for patent?

A. Yes.

Mr. ARMSTRONG. Q. And patent issued?

A. And patent issued.

Mr. LINN. Q. And that was the mold which was the infringing device referred to in this case?

A. Yes.

Q. When, in the year 1922, did you use this device?

A. In July, 1922.

Q. Defendant's Exhibit No. 1 in evidence.

A. In July, 1922.

Q. In July, 1922?

A. Yes.

Q. You discarded it after packing about six cans?

A. Yes.

Q. At that time did you in any way make any comparison of the cost of packing string beans with this mold Defendant's Exhibit No. 1, with the Greco device?

A. I did not, because it was not necessary.

Q. You did not?

A. No.

Q. In 1922, or 1923, did you use either of the devices No. 1 or No. 2 in evidence?

A. No, I did not.

Q. In 1924 did you use either of the devices in evidence?

A. Yes, I did.

Q. Which one?

A. No. 2.

Q. You used No. 2?

A. Yes.

Q. That is in the year 1924?

A. 1925.

The MASTER. How about 1924?

A. In 1924 I was working under my own mold; at the time the suit was still pending, I did not want to use this, on account of the threat of being sued, anyway, whether I packed them by hand, or not, so I thought I had better stay with my own mold, because of having a patent on it.

The MASTER. Q. You began to use No. 2 there in 1925?

A. In 1925.

Mr. LINN. Q. *You did not experiment any further with mold No. 1?*

A. No.

Q. *After 1922?*

A. No.

Q. You again took up the matter of experimenting with the mold or device other than the Greco patent in the year 1925?

A. In 1925 we used the hand method."

(Testimony of I. Rancadore, Record, page 78, et seq.)

Let the witness Eugene J. Filice, an employee of appellant's assignor, tell of the experiment which he carried on at the request of defendant and to the betrayal of his employer:

"Q. Then when did you first start working on mold No. 1?

A. On this mold No. 1, in July of 1922.

Q. July, 1922?

A. With this No. 1.

Q. Where were you then working?

A. I was working for Mr. Greco at that time. This **experimenting** took place one evening, late one evening.

Q. While you were still working for Mr. Greco?

A. Yes.

Q. You went over to the San Jose Canning Company?

A. Yes.

Q. And worked on this No. 1 mold?

A. Yes.

Q. It was evident at that time that asparagus-pack string beans were a success?

Mr. ARMSTRONG. I object to that as calling for a conclusion of the witness.

Mr. LINN. Let me finish the question.

Q. You were working with Mr. Greco on that pack and you went over in the evening to see Mr. Rancadore, and tried to work out something else?

The MASTER. That is simply a comment on the evidence already in.

Mr. LINN. I will withdraw the question.

Q. In 1922 you worked at night on this model No. 1?

A. Yes.

Q. And canned about six cans of string beans?

A. Yes, about six cans.

Q. At night?

A. Yes.

Q. Did you work nights in that plant?

A. I was not working there, I was called there on account of some difficulty they were having in the No. 10 gallon cans; they were having trouble with the bulging out of them after they were cooked; the gallon cans were not coming out perfect.

The MASTER. Q. Now, just tell me what happened.

A. I was called over there by this Mr. Cusimano, who was assistant superintendent at the time, and who was taking care of this cooking, and on account of this difficulty he came and got advice from me while I was in the employ of Mr. Victor Greco, so I promised him I would be over that evening and help him out on it, and while I was there that evening looking over his difficulty in the No. 10 cans, this thing had been brought out, after I was there a while, and we tried the packing of string beans with this No. 1 mold.

Q. What was done?

A. Well, Mr. Rancadore, and Mr. Cusimano, and myself, we got some string beans, we blanched them, we put beans in this No. 1 form, here, we cut off one end, and later the other, and then we got the beans by hand and placed the back part of this bunch into the can, first, and then applied the thumbs, in squeezing, got the front part started, and when that was done, with the aid of bouncing, we began pushing into the can, and we saw they would slide down into the can very conveniently.

Q. What did the beans look like after that?

A. They looked exactly like they would with the mold that we used, in fact they were better; you could get more in there; due to the mold

being smaller in diameter than the can, you naturally could not get as many in with that as you could squeezing them by hand.”

(Testimony of Eugene J. Filice, Record, pages 93 et seq.)

The witness Matteo Cusimano was the third person who took part in the development of Exhibits 1 and 2. The following excerpt from his testimony discloses the nature and character of the experiment:

“A. Mr. Rancadore said that he would like to have something of this kind to see how it would work, and I worked it out the best I could. I bent up a couple of pieces of iron.

Mr. ARMSTRONG. Q. Did you see them trying to pack beans, using that mold?

A. Yes.

Q. When was that done?

A. That was that same evening that I had made that.

Q. Did they pack any beans from that mold into cans?

A. They packed a few cans, yes.

Q. How did it work? Were they able to pack?

A. It was satisfactory, as far as I understand from Mr. Rancadore.

Q. They had to lift the beans out of the mold and put them into the can?

A. Yes.

Q. Did they make a good, solid pack?

A. They filled in pretty good.

Q. How about the cutting of the beans? The beans have to be cut, don't they?

A. Yes.

Q. How about the cutting of the ends on that No. 1 mold, that one, there, that you made?

A. The only difficulty is when the knife is dull. If the knife is good and sharp it cuts every one. In fact, we had no trouble at that time.

Q. Were you employed continuously from 1922 on by the San Jose Canning Company?

A. Practically, yes.

Q. Are you employed by them now?

A. Yes.

Q. In 1922, were you familiar with the method of packing beans in bunch form, asparagus style?

A. No, that is, not in asparagus style.

Q. You are not familiar with the canning?

A. No.

Q. Do you know how the San Jose Canning Company packed them in those years?

A. The way they packed, when I had work in there and saw, there was no mold used in those years.

Q. But when they packed them in 1922, do you know how they packed?

A. When I went in in 1922, when they started in in July, I found this mold, and it was already prepared to be used for the asparagus style of beans, so we did start out and we worked a few days, a week or so, I wouldn't say any more, and that was the time, I made this, and we tried it out.

Q. You got it out and you packed the beans with it?

A. Yes, tried it out.

Q. Have you ever seen that Mold No. 2 there?

A. Yes.

Q. Defendant's Exhibit No. 2?

A. Yes.

Q. When did you first see that?

A. The No. 2, I don't remember exactly, but I think it was in 1924; if I don't mistake it was in 1924. I seen Mr. Filice trying it out.

Q. In that year they used quite a few of these, did they?

A. Just **experimented** in 1924.

Q. How about 1925?

A. In 1925 they began using them."

(Testimony of Matteo Cusimano, Record, page 110, et seq.)

The experiment (ignoble in purpose) thus portrayed by the witnesses, is not available for use as a "standard of comparison" herein. It had not been completed prior to 1925 and after the infringement. It was not "known," "open to the public," "in common use," "open to the defendant," or "open to the world," prior to 1925.

Funk & Wagnalls, in their New Standard Dictionary (1914), define the word "known" as follows:

"known: apprehended mentally; recognized; understood; especially, recognized by all as the truth; as, his honesty is *known*; *known* and unknown quantities."

and gives as a synonym therefor the words "eminent" and "notorious."

The same dictionary gives "notorious" as a synonym for the word "open."

The word "available" is therein defined as follows:

"available: 1. capable of being employed or made use of to advantage; suitable for the accomplishment of a purpose; usable; at one's disposal; profitable; as, an available excuse; available assets. 2. Sufficient in power or efficacy for producing the desired results; effectual; valid; as, an available argument."

"Common" is thus defined:

"common: 2. Pertaining to, belonging to, or participated in by two or more persons, things, or parts alike; participating in or appertaining to all or the whole; joint; general; public; as, death is common to the human race; my brother and I are common owners of the estate."

and among the synonyms therefor are "common-place," "customary," "everyday," "public," etc.

Judge Bourquin states the rule in the case of
Minerals Separation v. Butte Superior Mining
Co., 274 Fed. 878,
 as follows:

“The rule of comparison is settled law, and contemplates that the infringer had a choice of processes, chose that of the patent, and gained an advantage over what would have been his had he chosen otherwise. Obviously his choice is made from processes existing at the time of infringement, from day to day, and as alternative presents itself.”

In the western district of New York the same rule was announced and applied to the facts in the case of
Philadelphia R. Wks. v. U. S. Rubber Reclaim
Wks., 276 Fed. 600, at page 605:

“The non-infringing alkali process later adopted by defendants, and known to them since 1906, *is not shown to have been advantageously used at any time before the infringement.* In its adaptation in 1915 it may fairly be assumed that information was acquired by defendants enabling them to develop or modify the Marks process, and any modified process was not, in my opinion, a proper standard of comparison.”

The last cited case went on appeal to the Circuit Court of Appeals, Second Circuit, and was affirmed in the case of

Philadelphia R. Wks. v. U. S. Rubber Reclaim
Wks., 277 Fed. 171, 176:

“(4) The standard of comparison, to be applicable, **must have been known** and open prior to the date of the plaintiff’s patent. *Illinois Central Co. v. Turrill*, 110 U. S. 301, 4 Sup. Ct. 5, 28 L. Ed. 154; *Sessions v. Romadka*, 145 U. S. 29, 12 Sup. Ct. 799, 36 L. Ed. 609. Some courts have

held the date of appropriation of the invention by the defendant should be taken. *Brown v. Lanyon*, 179 Fed. 309, 102 C. C. A. 497; *Columbia Wiring Co. v. Kokomo*, 194 Fed. 108, 114 C. C. A. 186; *Amer. Pneumatic Co. v. Snyder* (D. C.) 241 Fed. 274. The field of selection of process which might be used should be, in principle, *that which is open to the art* at the time the invention is appropriated. Where there is a patent which forbids such use, the question is presented whether it is actually available to the infringer during the period of the infringement. Where the owner of the patent declines to permit its use or grant a license, it cannot be set up as a standard of comparison.

“(5) *Processes which were developed after the infringement as a substitute for use by the defendants cannot be used as a standard of comparison. This record discloses no process that might be used as a standard of comparison. The rule is therefore applicable which requires the defendants to pay over to the plaintiff all the profits which they derived through unlawful infringement.* *Westinghouse v. Wagner*, 225 U. S. 604, 32 Sup. Ct. 691, 56 L. Ed. 1222.”

In this circuit Judge Gilbert announced practically the same rule in the case of

Fullerton W. G. Assn. v. Anderson-Barngrover Mfg. Co., 166 Fed. 443, at page 453:

“The advantage which the defendant derived from using the complainant’s invention, over what he could derive from using any other process or thing which was *known* prior to that invention, constitutes the profits which the complainant is entitled to recover.”

The use of processes in the experimental stage at the time of the infringement was condemned in the case of

Expanded Metal Co. v. General Fireproofing Co., 247 Fed. 899, at page 909:

“(7) If my decision were to rest on the differences between the two products, or the question of whether or not the corrugated process was adequate to produce the same product as is produced by complainant’s process, it would be difficult to sustain the master’s conclusion. Other considerations, however, are present, which bring me to the same conclusion as the master. *I am of opinion that a process yet in the experimental stage, and developed for the purpose only of avoiding infringement, made at or after the appropriation by the infringer of the other’s process, and covered by a patent to itself—that is, used experimentally and occasionally only during the infringing period, or only under compulsion of an injunction, and abandoned as soon as the infringer is at liberty to change back—does not make a case of another existing process, or means, open to the public and to the defendant, or constitute a basis of comparison in determining the gains and advantages from the use of the infringing process over other processes.*

“In Walker on Patents (5th Ed.) S. 725, it is said that the other article or process to be used as a basis of comparison must have been known or in existence prior to the date of the patent which is infringed; in other words, that the standard of comparison must have been known in the art prior to the complainant’s invention. In *Turrill v. Illinois Central R. R. Co.* (G. C.) 20 Fed. 912, it is explicitly stated that the process or article to be used as a basis for comparison must have been *open to the public* at the date of the patent which is infringed. Many excellent reasons are advanced in the opinion in support of this conclusion. The judgment in the case was affirmed by the United States Supreme Court in *Illinois Central R. R. Co. v. Turrill*, 110 U. S. 502, 4 Sup. Ct. 5, 28 L. Ed. 154. In *Sessions v.*

Romadka, 145 U. S. 29, 45, 12 Sup. Ct. 799, 803 (36 L. Ed. 609), Mr. Justice Brown says:

‘This court has, however, repeatedly held that in estimating damages in the absence of a royalty it is proper to consider the savings of the defendant in the use of the patented device over what was *known and in general use* for the same purpose anterior to the date of the patent.’

“An examination of *McCreary v. Pennsylvania Canal Co.*, 141 U. S. 459, 464, 465, 12 Sup. Ct. 40, 35 L. Ed. 817, convinces me that it is not in conflict with this statement of the law.

“Defendant contends that any article or process available to an infringing defendant at any time may be used as a basis of comparison. Strong reasons are advanced why the date of complainant’s patent should not be taken in determining the process open or available to the public or defendant. Whether these reasons should prevail over the reasoning of the learned judge in *Turrill v. Illinois Central R. R. Co.*, *supra*, I deem it unnecessary to express an opinion. I am of opinion, however, from an examination of all the cases cited, that *the other available process must have been in existence and open to public use in its completed form at the time the infringer appropriates a patented process; he should not be permitted to avail himself of inventions developed by himself or others after he has appropriated another’s property for the purpose of mitigating or avoiding the damage thus inflicted on another.*”

The Supreme Court of the United States has passed upon questions similar to the one here involved. In the case of

Mowry v. Whitney, 14 Wall. 620, 81 U. S. 620;
20 L. Ed. 860,

the rule as to a “standard of comparison” is laid down as follows:

“The question to be determined in this case is: what advantage did the defendant derive from using the complainant’s invention over what he had in using *other processes then open to the public and adequate to enable him to obtain an equally beneficial result?* The fruits of that advantage are his profits. They are all the benefits he derived from the existence of the Whitney invention.”

The same rule was approved in the case of

Goulds Mfg. Co. v. Cowing, 105 U. S. 253; 26 L. Ed. 987.

In the case of

Black v. Thorne, 111 U. S. 122; 28 L. Ed. 372,
the court held the true rule to be:

“The question, therefore, was, what advantage in its production did the use of the improvements in burning wet tan have over other *known* methods in *common use* of producing the same result, that is, the same heat?”

In the instant case it was clearly demonstrated that at the time of the infringement there was no “*known*” method of canning string beans asparagus style “*in common use.*” Therefore, no “standard of comparison” is available to defendant.

The doctrine set forth in the case of *Mowry v. Whitney*, *supra*, is cited with approval in the cases of

Tilgham v. Proctor, 125 U. S. 136; 31 L. Ed. 664;

Sessions v. Romadaka, 145 U. S. 29; 36 L. Ed. 609.

CONCLUSION.

It is respectfully submitted that a "standard of comparison" should be known at or prior to the time of infringement in order to be available to an infringer. Not only must it be "known" but it must be "known to the public." The "standard of comparison" must have passed the experimental stage and be available commercially.

An examination of the authorities leads to the conclusion that the rule of a "standard of comparison" does not contemplate a secret or unknown thing. Something to be conjured up at a midnight meeting under the stress and threat of an injunction proceeding as happened in this case.

If the rule permitted otherwise, all an infringer would have to do would be to work out the new process when caught infringing and then say that he knew of the new process all the time, and none could gainsay him. When the courts use the word "known" as applied to a "standard of comparison," they mean nothing less than recognized, understood and even notorious. In addition to the word "known" the Courts use the words "open to the public," "available," "in common use," etc., all contradicting the idea of a secret process or something only known to an individual or available in the sense that everything in being or in contemplation is available if one but discovers it.

The record clearly discloses that prior to the patent of appellant, string beans were not canned "asparagus style;" that thereafter they were not so canned except by appellant's predecessors in interest and assignors,

until the appellee infringed the patent. Therefore no standard of comparison is available to appellee and appellant is entitled to all of defendant's profits derived from the sale of string beans "asparagus style" during the years 1923 and 1924.

We respectfully submit that the judgment of the District Court should be reversed with directions to again refer the matter of the accounting to the special master for the purpose of ascertaining all of appellee's profits derived from the sale of string beans "asparagus style" during the period in question and to render judgment in favor of appellant therefor.

Dated, San Francisco,
May 22, 1929.

Respectfully submitted,

CLARENCE A. LINN,
Attorney for Appellant.